

REMARKS

Claims 11-28 will be pending upon entry of the present amendment. Claims 1-10 are being canceled. Claims 16-28 are new.

In response to the Restriction Requirement dated April 1, 2004, the applicants have elected with traverse, Group II, claims 11-13, for examination at this time. The applicants traverse the restriction requirement as applied to Groups II, III, and IV.

With respect to the claims of Groups II and III, the applicants respectfully submit that the Examiner has not established that either of the inventions of Groups II and III has a separate utility other than in the combination of the two subcombinations. As stated in MPEP § 806.05(d), "the Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." One disclosed combination is an error control method that codes a word in a first base into a codeword in a second base for storage and then decodes the codeword in the second base (see, for example, claim 13). Claim 11 of Group II is directed to an error method that codes a word in a first base into a word in a second base and claim 14 of Group III is directed to an error control method that decodes a word in a first base into a word in a second base.

The Examiner has not pointed to any use of the error control method of claim 11 or the error control method of claim 14 other than in the disclosed combination of an error control method that codes a word in a first base into a codeword in a second base for storage and then decodes the codeword in the second base. The Examiner states that the Group II invention has separate utility such as in encoding. However, the Examiner has not shown a use of the Group II invention in an encoding method other than as part of the above-mentioned disclosed combination of an error control method that codes and decodes using first and second bases. In other words, the Examiner has not shown any encoding method that uses the error control method recited in claim 11 that is not part of a combination that also decodes the codewords produced in by the claim 11 method. Similar considerations apply to the Group III invention.

Accordingly, the Examiner has not shown that the Group II and III inventions are distinct.

In addition, the Examiner has not shown that examining claim 14 together with claims 11-13 would present a serious burden. As stated in MPEP §803, "if a search and

examination of an entire application can be made *without serious burden*, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” The Examiner admits on page two that the claims of Groups II and III are all classified in the same class and subclass: class 714, subclass 776. Given their identical classification, it is difficult to imagine how examining claim 14 with claims 11-13 would present a serious burden. Moreover, claim 14 includes language that is almost identical to that of claim 13, so there is no way to examine claim 13 without examining claim 14.

For the foregoing reasons, the applicants respectively submit that restriction between the claims of Groups II and III is not proper.

With respect to the claims of Groups II and IV, the applicants respectfully submit that the Examiner has not established that the process as claimed in claim 11 (Group II) can be practice by an apparatus that is materially different from the apparatus of claim 15 (Group IV) or that the apparatus of claim 15 can be used to practice a process that is materially different than that of claim 11.¹ See MPEP § 806.05. As mentioned above, claim 11 recites a method that converts words from a first base to codewords in a second base and stores the codewords in memory. Similarly, claim 15 recites a device structured to convert words from a first base to codewords in a second base and stores the codewords in memory. The Examiner has not pointed to a materially different apparatus for practicing the process of claim 11 or to a materially different process performed by the apparatus of claim 15.

The Examiner noted that the invention of Group II “has a separate utility such as in encoding,” but the Examiner does not point to any encoding that is materially different from the encoding performed by the device of claim 15. Similarly, the Examiner noted that the invention of Group IV “has a separate utility such as in memory access,” but does not point to any memory access that is materially different from the memory access performed by the process of claim 11. That is, the memory access performed by the device of claim 15 must at least including writing into memory a codeword that has been converted from a first base to a second base, which the Examiner has not shown to be materially different from the process of claim 11.

Accordingly, the claims of Groups II and IV are not distinct.

¹ The Examiner mistakenly asserted that the claims of groups II and IV are related as subcombinations disclosed as usable together in a single combination. Instead, groups II and IV are related as process and apparatus for its practice, and thus, is covered by MPEP § 806.05.

In addition, the Examiner has not shown that examining claim 15 together with claims 11-13 would present a serious burden. By entering the Restriction Requirement, the Examiner is contending that while searching the claim 11 process that converts/encodes a word of a first based into a codeword of a second base, he would not also search art classes that cover a device that converts/encodes a word of a first based into a codeword of a second base. It is unclear to the applicants how such a search for the process of claim 11 without simultaneously searching the device of claim 15 is even possible given the similarity of language in the two claims.

For the foregoing reasons, the applicants respectively submit that restriction between the claims of Groups II and IV is not proper.

In making the above arguments, the applicants do not admit that the any of the independent claims are obvious in light of one another. The Applicant further does not admit that such classes are appropriate for search, should the Examiner persist in the restriction requirement. In light of the foregoing remarks, the Applicants respectfully request that the Restriction Requirement as applied to Groups II, III, and IV be withdrawn and all pending claims be examined.

New claims 16-25 depend on claim 11, and thus, should be examined with claims 11-13. New claims 26-28 are apparatus claims that include means for practicing the process of claims 11-13. Thus, as recited in MPEP § 809.04, claims 26-28 are linking claims that must be examined with the elected invention recited in claims 11-13.

Consideration of the pending claims is now requested.

Respectfully submitted,
Seed Intellectual Property Law Group PLLC



Robert Iannucci
Registration No. 33,514

Enclosure:
Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900 / Fax: (206) 682-6031
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